

REMARKS

Claims 1-23 are pending in the application. Claims 1-23 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable by U.S. Patent Publication No. 2002/0010757 (Granik), U.S. Patent No. 5,751,961(Smyk et al.), U.S. Patent No. 6,108,655 (Schleimer et al), U.S. Publication No. 2002/0054114 (Shuping et al.) and U.S. Patent No. 6,895, 418 (Crow et al.). Of the Claims, Claims 1, 12 and 21 are independent. Claims have been amended to clarify the Applicants' invention. The application as amended and argued herein, is believed to overcome the rejections.

Regarding Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 12-14, and 21-23 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent Publication No. 2002/0010757 (Granik) in view of U.S. Patent No. 5,751,961(Smyk).

Claims 4-8 and 15-19 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent Publication No. 2002/0010757 (Granik) as applied to Claims 1 and 2 above, in view of U.S. Patent No. 5,751,961(Smyk) in further view of U.S. Patent No. 6,108,655 (Schleimer).

Claims 9 and 20 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent Publication No. 2002/0010757 (Granik) in view of U.S. Patent No. 5,751,961(Smyk) in further view of U.S. Patent No. 6,895, 418 (Crow).

Claims 10 and 11 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent Publication No. 2002/0010757 (Granik) in view of U.S. Patent No. 5,751,961(Smyk) in further view of U.S. Publication No. 2002/0054114 (Shuping).

To establish a prima facie case for obviousness under 35 U.S.C. 103(a), (1) there must be some suggestion or motivation to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the references when combined must teach or suggest all the claim limitations. For the reasons discussed below, it is respectfully submitted that the Office has not established a prima facie case under 35 U.S.C. 103(a) for claims 1-23 and that therefore, claims 1-23 are allowable.

Cited Reference, Granik discusses providing an address (URL) for downloading new advertising content that is determined based on user profile information. (See Granik, Abstract.)

Cited reference Smyk discusses an ISCP gateway that translates logical addresses in the URL standard to physical www addresses in the URL standard. The physical www addresses are used by web browsers to request documents. (See Smyk, Abstract.)

The references when combined do not teach or suggest all the claim limitations

Neither Granik nor Smyk teach or suggest at least:

“transmitting from said content server to said end-user computer, in response to said end-user request, said content comprising at least one storage resource locator ("SRL"), wherein said SRL comprises a unique file identifier generated from the contents of a file to identify the file associated with said content”

as claimed by the Applicants in Claim 1 (emphasis added).

Smyk merely discusses translating a “logical address” to a “physical www address”. Both the logical address and the physical www address provide the location of a file. There is no teaching or suggestion of using “contents of a file to identify the file” as claimed by the Applicants. In contrast, the addresses discussed by Smyk merely indicate the location of the file, that is, where the file is stored, for example, in a particular directory in a file system. The filename is merely assigned to the file to distinguish the file from other files stored in the same directory. However, another file stored in the directory having a different filename may have the same file contents.

Thus, the file_path_string that includes “the file name and the directories the file is stored in” does not teach the Applicants’ claimed “unique file identifier” that is “generated from the contents of a file”. In contrast, in Smyk’s system, “contents of a file” identified by a “file_path_string” may be stored at multiple addresses (physical/logical) in the system. Each file is uniquely addressed using the file_path_string which identifies the path used to locate the particular filename (directories, filename) associated with the file. (See Smyk, col. 3, lines 4-10.)

Furthermore, Applicants' respectfully disagree with the Office's suggestion that the Applicants' claimed SRL corresponds to the URL discussed in the prior art. The Applicants' claimed SRL differs from the URL discussed in the prior art. As shown in the Applicants' specification Fig. 25, the applicants' claimed SRL transmitted to the storage center differs from the URL which is transmitted to the web browser. For example, cited prior art Smyk defines a URL to be a hard coded physical address. (See Smyk col. 2, lines 6-7.) Thus, the URL discussed by the prior art does not teach or suggest the Applicants' claimed "SRL" which is defined in the Applicants' specification to be a Storage Resource Locator and is based on the "contents of the file" not on the address (file path, that is, directories and filename).

Therefore, separately or in combination, Granik and Smyk do not teach or suggest the Applicants' claimed invention as claimed in Claim 1. Even if combined, the present invention as now claimed does not result as argued above.

Regarding rejection of dependent Claims 4 and 15, cited art Schleimer merely discusses embedding a URL in a web page. However, as already discussed, the URL discussed by Schleimer does not teach or suggest the Applicants' claimed "SRL". Thus, Schleimer does not teach or suggest the Applicants' claimed "embedding an SRL".

The Office fails to identify a suggestion or motivation to combine reference teachings

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990.)" (See MPEP 2143.01 III.)

The Office fails to identify a suggestion or motivation in the prior art for combining Granik and Smyk. The Office action merely states: "it would have been obvious for one having ordinary skill in the art at the time of the invention to combine the teachings of Granik and Smyk to allow the identification of files to be easily achieved by simply using the file path which is available directly from the file." This merely states an advantage of combining Granik and Smyk that is not the same as showing a motivation to combine the references. There must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. (See In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).)

The Office fails to identify a suggestion or motivation in the prior art for combining Granik, Smyk and Schleimer. The Office action merely states: “it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Granik and Smyk with the teaching of Schleimer in order to be able to identify the location where the content is stored and be able to retrieve it.” This merely states an advantage of combining Granik, Smyk and Schleimer, that is, “to be able to identify the location where the content is stored and be able to retrieve it”.

The Office fails to identify a suggestion or motivation in the prior art for combining Granik, Smyk and Crow. The Office Action merely states “it would have been obvious to one having ordinary skill in the art at the time the invention to combine the teachings of Granik and Smyk with the teaching of Crow in order to have a plurality of SRLs more organized via a file system which also provides more flexibility for extending existing files”. This merely states an advantage of combining Granik, Smyk and Crow, that is, “flexibility for extending existing files”.

The Office fails to identify a suggestion or motivation in the prior art for combining Granik, Smyk and Shuping. The Office Action merely states “it would have been obvious to one having ordinary skill in the art at the time the invention to combine the teachings of Granik and Smyk with the teaching of Shuping in order to facilitate the transmission of the request and the retrieved web pages through a network such as the Internet”. This merely states an advantage of combining Granik, Smyk and Shuping, that is, “facilitate transmission through a network”.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). The Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modifications.

Furthermore, Granik is directed to an advertisement replacement system, Smyk is directed to Internet Services, Shuping and Schleimer are directed to a network browsing system and Crow is directed to extent based file systems. One of ordinary skill in the art of an advertisement replacement system would not look to Smyk, Shuping, Schleimer and to provide “transmitting from said content server to said end-user computer, in response to said end-user request, said content comprising at least one storage resource locator ("SRL"), wherein said SRL

comprises a unique file identifier generated from the contents of a file to identify the file associated with said content ” as claimed by the Applicants in claim 1.

Claims 1-11 are dependent claims that depend directly or indirectly on claim 1, which has been shown to be non-obvious over the cited art. Independent claims 12 and 21 recite a like distinction and are thus non-obvious over the cited art. Claims 12-20 depend directly or indirectly on claim 11 and claims 22-23 depend directly or indirectly on claim 21 and are thus non-obvious over the cited references.

Accordingly, the present invention as now claimed is not believed to be made obvious from the cited references. Removal of the rejections under 35 U.S.C. § 103(a) and acceptance of claims 1-23 is respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that all claims (claims 1-23) are in condition of allowance. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to Deposit Account Number 50-0221.

Respectfully submitted,

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